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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/872,713 | 06/01/2001 | Yasuhiro Kawaguchi | ADACHI P214US | 4248 |
| 20210 | 7590 | 04/20/2004 | EXAMINER | |
| DAVIS & BUJOLD, P.L.L.C. FOURTH FLOOR 500 N. COMMERCIAL STREET MANCHESTER, NH 03101-1151 | | | YOON, TAE H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1714 | |

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------|-------------------------------|-------------------------------------|---|
| Advisory Action | Application No. 09/872,713 | Applicant(s) KAWAGUCHI, YASUHIRO | |
| | Examiner Tae H Yoon | Art Unit 1714 |  |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 10-19.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.


Tae H Yoon
Primary Examiner
Art Unit: 1714

ATTACHMENT TO ADVISORY ACTION

Cancellation of a weight average molecular weight of between 7,000-50,000 in claim 19 raises new issues that would require at least further consideration, and thus the entry of amendment is denied. Said amended claim 19 would have been rejected under Nguyen (US 6,451,422) alone without said weight average molecular weight of between 7,000-50,000 in the final rejection mailed on January 8, 2004 rather than Nguyen (US 6,451,422) and Mercer et al (US 5,849,824). Thus, a rejection of said claim 19 under Nguyen (US 6,451,422) alone is needed with the entry of amendment, but such art rejection is not permitted after Final rejection.

Applicant's only rebuttal is directed to Nguyen (US 6,451,422) and Mercer et al (US 5,849,824) due to the amendment, and Nguyen teaches a liquid ethylene-propylene rubber (Trilene CP40 **which is an unvulcanized rubber since it is a liquid**) at col. 5, and said ethylene-propylene rubbers are taught as EPR and EPDM at col. 2, lines 19-20. Applicant asserts that Mercer et al teach away from the use of an unvulcanized EPDM, but the examiner recited Mercer et al in order to show the instant molecular weight, not an unvulcanized EPDM being already taught by Nguyen. A maleic anhydride modified EPDM taught at col. 4 shows a similar molecular weight distribution of EPDM segment (about 110) and maleic anhydride segment (about 100). Thus, the molecular weight (10,000 to 200,000) taught at col. 3, lines 60-61 would yield about 5,000 to 100,000 for the EPDM segment.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tae H Yoon
Primary Examiner
Art Unit 1714

THY/April 15, 2004